

REMARKS

This Supplemental Reply and Amendment is intended to be completely responsive to the non-final Office Action dated June 13, 2001, and the Notice of Non-Compliant Amendment dated September 25, 2001.

Notice of Non-Compliant Amendment

In the Notice of Non-Compliant Amendment (37 C.F.R. § 1.121) dated September 25, 2001, the Legal Instruments Examiner provided that the Reply and Amendment filed September 13, 2001, was "considered non-compliant because it has not been submitted in the format required under 37 C.F.R. § 1.121" and did "not include a clean version of the amended claims(s)."

The Applicants note that 37 C.F.R. § 1.121 does not apply in a reissue application.¹ As the Legal Instruments Examiner acknowledged, the Reply and Amendment filed September 25, 2001 was "bona fide." In this Supplemental Reply and Amendment, the Applicants provide Exhibits for the convenience of the Examiner with markings to show changes made relative to the previous version of the claims (Exhibit A) and relative to the claims of the patent being reissued (Exhibit B). It is the understanding of the Applicants that this Supplemental Reply and Amendment, with the Reply and Amendment filed on September 11, 2000 (incorporated by reference herein as modified), is fully responsive to the Office Action dated June 13, 2001, and the Notice dated September 25, 2001.

Objection to Amendment Under 37 C.F.R. §§ 1.173(b) and (g)

In Section 1 of the Office Action, the Examiner objected to the Preliminary Amendment filed April 27, 2001 as not being in compliance with 37 C.F.R. §§ 1.173(b) and 1.173(g). The Examiner stated:

While the amendment has been considered any response to this action must place the newly added claims (claims 39-95) in proper form for further consideration.

The Applicants apologize for their misunderstanding. This Supplemental Reply and Amendment is intended to be completely responsive to the objection made by the Examiner. The amendments to Claims 43, 71-72, 86, 92 and 95 in this

¹ 37 C.F.R. § 1.121(a) (emphasis added) "Amendments in applications, other than reissue applications, are made by"

Supplemental Reply and Amendment are presented relative to the patent being reissued.² The amendments to Claims 43, 71-72, 86, 92 and 95 are shown in Exhibit A relative to the previous version of those claims for the convenience of the Examiner.

Certain of pending Claims 39-92 and 95 correspond to issued Claims 1-20 of U.S. Patent No. 5,842,486, which is the basis for this Reissue Application. This correspondence is shown in EXHIBIT B with claims shown "marked up" relative to the claims of the '486 patent for the convenience of the Examiner.³

Status of Claims

Claims 39-42 and 46-70 have been allowed, dependent Claim 94 stands "objected to," and Claims 43-45, 71-93 and 95 stand rejected. On entry of this Reply and Amendment, Claims 93-94 will be cancelled without prejudice, and Claims 43, 71-72, 86, 92 and 95 will be amended for clarity. Accordingly, Claims 39-92 and 95 will be pending in this Application.

Allowable Subject Matter

Claims 39-42 and 46-70 have been allowed.

In Section 12 of the Office Action, the Examiner stated that Claims 71-84 would be allowable if "whereby" is inserted between "position" and "seal." Independent Claim 71 has been amended for clarity as prescribed by the Examiner.

In Section 12 of the Office Action, the Examiner stated that dependent Claims 43-45 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 ¶ 2 and to include all of the limitations of the base claim and any intervening claims. Dependent Claim 43 has been amended as prescribed by the Examiner. Dependent Claims 43-45 all ultimately depend from independent Claim 39, which as been allowed.

² 37 C.F.R. § 1.173(b) "If amendment is made by an amendment paper, the paper must direct that specified changes be made. . . . An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," etc., should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim."

³ Claims 1-38 (including Claims 1-20 of the '486 patent have been cancelled). Claims 39-94 were newly presented. See 37 C.F.R. § 1.173(d) "Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings"

In Section 12 of the Office Action, the Examiner stated that dependent Claim 94 would be "allowable" if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claims 93-94 have been cancelled without prejudice, and independent Claim 92 has been amended to recite in proper form subject matter the Examiner indicated would be "allowable." Specifically, the subject matter of dependent Claims 93-94 (as originally presented) has been incorporated into independent Claim 92.⁴

Accordingly, the Applicants request favorable reconsideration and allowance of dependent Claims 43-45 (which depend from allowed independent Claim 39), independent Claim 71 (and corresponding dependent Claims 72-84) and independent Claim 92 (and corresponding dependent Claim 95).

Claim Rejections - 35 U.S.C. § 112 ¶ 1

In Section 3 of the Office Action, the Examiner rejected Claims 85-91 as presented for examination under 35 U.S.C. § 112 ¶ 1 as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner stated:

Claim 85, lines 5-9 lack clear support within the specification as to what specifically the three "sealing surfaces" are, and accordingly constitutes New Matter.

Claim 86 lacks clear support as what constitutes the "planar" surface that seals.

⁴ Independent Claim 92 (as amended) has the same "scope" as dependent Claim 94 (as originally presented).

Dependent Claims 86 has been amended to no longer recite the term "planar." Exemplary support for the "channel" having "three sealing surfaces" as recited in independent Claim 85 is provided in the '486 patent at col. 5, lines 47-57 and FIGURES 3 and 7-8.⁵ Accordingly, the rejection to Claims 85-86 under 35 U.S.C. § 112 ¶ 1 has been overcome.

Claim Rejections - 35 U.S.C. § 112 ¶ 2

In Section 5 of the Office Action, the Examiner rejected Claims 43-45, 71-84 and 95 as presented for examination under 35 U.S.C. § 112 ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicants regard as the invention. The Examiner stated:

Claim 95 depends from itself.

Claim 43 appears as double recitation of the housing recited by claim 39, thereby confusing the subject matter of claim 45.

Claim 71, line 4, "position the seal" is awkward.

Dependent Claim 95 has been amended to depend from independent Claim 92 as prescribed by the Examiner. Dependent Claim 43 has been amended for clarity to further define the "housing" as prescribed by the Examiner. Independent Claim 71 has been amended for clarity to recite "whereby the seal maintains the cover in the closed position" as suggested by the Examiner. Accordingly, the rejection to Claims 43-45, 71-84 and 95 under 35 U.S.C. § 112 ¶ 2 has been overcome.

Claim Rejections - 35 U.S.C. §§ 102 and 103

In Section 6 of the Office Action, the Examiner rejected Claims 85-86, 89-90 and 92-93 under 35 U.S.C. §§ 102(a) and 102(e) as being anticipated by U.S. Patent No. 5,875,918 ("Sheffler et al."). In Section 10 of the Office Action, the Examiner rejected Claims 87, 91 and 95 under 35 U.S.C. § 103(a) as being obvious over Sheffler et al., a single reference.

1. Claims 92-93 and 95.

⁵ See '486 patent, col. 5, lines 47-57: "In the process of closing insert 22, groove 48 receives peripheral rim 36 between first peripheral wall 44 and peripheral edge 33 (FIGS. 4, 6, and 8), thereby effecting a hermetic, i.e., air-tight, seal at the interface. The seal can be formed between peripheral wall 34 and peripheral wall 44 or rim 36 and edge 33. Moreover, bulge 54 of peripheral edge 33 pushes peripheral rim 36 to bias peripheral wall 34 towards peripheral wall 44. Even further, lip 38 of peripheral rim 36 fits into indentation 56 of peripheral edge 33, thus securing the hermetic seal and maintaining insert 22 in the closed configuration."

In response to the rejection of Claims 92-93 and 95 under 35 U.S.C. §§ 102 and/or 103, the Applicants make this statement:

Independent Claim 92 has been amended to recite in proper form subject matter the Examiner indicated would "allowable" (i.e. patentable over the cited references). Claims 93-94 have been cancelled. By amending and canceling such claims, the Applicants wish to make it unmistakably clear that they do not agree to or acquiesce in the rejections to Claims 92-93 and 95 and/or agree with the Examiner's view of the scope and the content (i.e. disclosure) of Sheffler et al.⁶ The Applicants have amended and cancelled such claims only to obtain prompt allowance of claims reciting subject matter indicated as allowable by the Examiner.

2. Claims 85-91.

Sheffler et al. shows a "container" having a "sealing mechanism which relies essentially on a relatively high, linear or in-like pressure track or area that is established by a sharp, substantially 90 degree apex or corner configuration" (Sheffler et al. at col. 5, lines 26-29 and Figures 1-2). Sheffler et al. does not identically disclose the combination of elements recited in independent Claim 85 (as originally presented). For example, independent Claim 85 recites a "compact for storing makeup" including, among other elements, "a first platform coupled to a second platform and configured for selective movement between a first position and a second position," a "rim extending from the second platform," a "channel disposed between a first wall and a second wall of the first platform and having at least three sealing surfaces," providing a "hermetic seal between the first platform and the second platform at two of the sealing surfaces," which is not identically disclosed in Sheffler et al. Accordingly, independent Claim 85 (and corresponding dependent Claims 86-91) are not anticipated by Sheffler et al. under 35 U.S.C. §§ 102(a) and 102(e) and are patentable.

Dependent Claims 87 and 91 depend from independent Claim 85. The subject matter recited in dependent Claims 87 and 91 would not have been obvious over Sheffler et al., a single reference, under 35 U.S.C. § 103(a). Sheffler et al. shows a "container" having a "sealing mechanism." However, Sheffler et al. would not result in the subject matter recited in independent dependent Claims 97 and 91. Sheffler et al., alone or in any proper combination, does not disclose, teach or suggest the

⁶ At this time, the Applicants maintain that such claims recite subject matter patentable over the cited references.

"compact for storing makeup" as recited in Claims 87 and 91. Moreover, the suggestion to make the combination of Sheffler et al. and forming "one of the rims of the upper and/or lower case part of Sheffler et al." to reduce "wear/stress at the seal points" has been taken from the Applicants' own specification (using hindsight), which is improper. Furthermore, to transform Sheffler et al. into the "compact for storing makeup" recited in dependent Claims 87 and 91 would require still further modification, and such modification is taught only by the Applicants' own disclosure.

The subject matter recited in dependent Claims 87 and 91, considered as a whole, would not have been obvious to a person having ordinary skill in the art. The rejection of dependent Claims 87 and 91 over Sheffler et al., a single reference, under 35 U.S.C. § 103(a) is improper. Therefore, dependent Claims 87 and 91 are patentable over Sheffler et al.

* * *

It is submitted that each outstanding objection and rejection to the Application has been overcome, and the Application is in a condition for allowance. On entry of this Reply and Amendment, Claims 39-92 and 95 will be pending in this Application. The Applicants respectfully request favorable reconsideration and allowance of all pending Claims 39-92 and 95.

The Examiner is invited to telephone the undersigned if such would advance the prosecution of the Application.

Respectfully submitted,

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EXHIBIT A
Version with Markings to Show Changes Made
Relative to Previous Version of the Claims

43. (Once Amended) The makeup container of claim 39, [further comprising:]
wherein the housing comprises an outer body coupled about the cover piece and the base piece, wherein the outer body includes a cavity, the cavity allowing expansion of the cover piece or the base piece.

71. (Once Amended) A makeup case for holding a cosmetic substance, the case including a cover and a base, the cover being movable to an open position and to a closed position, an improvement comprising:

 a hermetic seal when the cover is in the closed position whereby the seal maintains the cover in the closed position;

 an outer body configured for retaining the cover and the base within the body.

72. (Once Amended) The makeup case of claim 71, wherein the seal comprises [of] a groove associated with the cover and a peripheral rim associated with the base, the rim being received in the groove when the cover is in the closed position.

86. (Once Amended) The compact of claim 85, wherein at least one of the sealing surfaces comprises a [planar] wall.

92. (Once Amended) A container for storing cosmetics comprising:
base means for providing a base;
cover means for providing a cover selectively positionable between a first position and a second position relative to the base means;
seal means for forming a hermetic seal between the cover means and the base means wherein the seal means comprises:

a curved rim extending from one of the cover means or the base means and a groove configured for receiving the rim disposed between a first wall and a second wall extending from one of the cover means or the base means;

a housing configured for retaining the base means and the cover means;

wherein the hermetic seal is formed when the cover means is in the first position.

95. (Once Amended) The container of claim [95] 92, wherein the seal means comprises an insert.

EXHIBIT B
Version with Markings to Show Changes Made
Relative to Patent Being Reissued

39. (Amendments relative to Claim 1 of the '486 patent) A makeup container, the container comprising:

a cover piece having a first interface, the first interface having a first periphery; and

a base piece for holding a cosmetic substance, the base piece having a second interface, the second interface having a second periphery corresponding to the first periphery, wherein the first interface and the second interface provide a hermetic seal when the cover piece is closed with respect to the base piece, wherein the seal comprises a groove associated with one of the first interface or the second interface and a peripheral rim associated with the other of the first interface or the second interface;

a housing having a base coupled to a cover wherein the cover piece and the base piece are configured to fit at least partially within the housing.

40. (Amendments relative to Claim 2 of the '486 patent) The makeup container of claim [1] 39, wherein the groove is defined by a peripheral wall and the peripheral edge of the peripheral rim being received between the first periphery and the peripheral wall.

41. (Amendments relative to Claim 3 of the '486 patent) The makeup container of claim [2] 40, wherein the first periphery includes a bulge.

42. (Amendments relative to Claim 4 of the '486 patent) The makeup container of claim [3] 41, wherein the first periphery and the second periphery are circular.

43. (Amendments relative to Claim 5 of the '486 patent) The makeup container of claim [1] 39, [further comprising:] wherein the housing comprises an outer body coupled about the cover piece and the base piece, wherein the outer body includes a cavity, the cavity allowing expansion of the cover piece or the base piece.

44. (Amendments relative to Claim 6 of the '486 patent) The makeup container of claim [5] 43, wherein the cavity is large enough to allow expansion during loss-in-weight tests.

45. (Amendments relative to Claim 7 of the '486 patent) The makeup container of claim [6] 44, wherein the [first] cover piece and the [second] base piece are integral and joined by a living hinge.

46. (New relative to claims of the '486 patent) The makeup container of claim 39, wherein the base of the housing is hingeably coupled to the cover of the housing.

47. (New relative to claims of the '486 patent) The makeup container of claim 46, wherein the base piece and the cover piece comprise an insert.

48. (New relative to claims of the '486 patent) The makeup container of claim 47, wherein the insert is configured to fit within the housing in a snap fit arrangement.

49. (New relative to claims of the '486 patent) The makeup container of claim 47, wherein the rim is configured to secure the insert at least partially within the housing.

50. (New relative to claims of the '486 patent) The makeup container of claim 49, wherein the rim is configured to couple the insert at least partially within the housing in a snap fit arrangement.

51. (New relative to claims of the '486 patent) The makeup container of claim 46, wherein at least one of the base piece and the cover piece include an interface for selectively moving the base of the housing relative to the cover of the housing.

52. (New relative to claims of the '486 patent) The makeup container of claim 46, wherein the housing comprises a shell.

53. (New relative to claims of the '486 patent) The makeup container of claim 46, wherein the rim comprises an overhang.

54. (New relative to claims of the '486 patent) The makeup container of claim 46, wherein the housing comprises a container.

55. (New relative to claims of the '486 patent) The makeup container of claim 41, wherein the bulge is curved.

56. (New relative to claims of the '486 patent) The makeup container of claim 49, wherein the rim is curved.

57. (Amendments relative to Claim 8 of the '486 patent) A compact for containing a cosmetic substance with an air-tight seal, the compact comprising:

a first section; and

a second section, the first section engaging the second section to form the air-tight seal, the air-tight seal maintaining the first section in a closed position with respect to the second section;

a housing configured for retaining the first section and the second section at least partially within the housing in a snap fit arrangement.

58. (Amendments relative to Claim 9 of the '486 patent) The compact of claim [8] 57, wherein the compact makes an audible sound indicating the air-tight seal is established when the first section engages the second section.

59. (Amendments relative to Claim 10 of the '486 patent) The compact of claim [9] 58, wherein the first section has a first circular cavity, the circular cavity having a first peripheral wall, wherein the second section has a second peripheral wall, the second peripheral wall sliding between the first peripheral wall and an edge of the first circular cavity to form the seal.

60. (Amendments relative to Claim 11 of the '486 patent) The compact of claim [10] 59, wherein the peripheral wall includes a lip.

61. (Amendments relative to Claim 12 of the '486 patent) The compact of claim [11] 60, wherein the lip extends away from an outside surface of a rim.

62. (Amendments relative to Claim 13 of the '486 patent) The compact of claim [13] 59, wherein the second section has a second circular cavity for holding the cosmetic substance, the second circular cavity being defined by the second peripheral wall.

63. (New relative to claims of the '486 patent) The compact of claim 57, wherein the housing comprises a shell.

64. (New relative to claims of the '486 patent) The compact of claim 57, wherein the lip is curved.

65. (New relative to claims of the '486 patent) The compact of claim 63, wherein the shell comprises a base and a cover.

66. (New relative to claims of the '486 patent) The compact of claim 63, wherein the first section and the second section comprise an insert.

67. (New relative to claims of the '486 patent) The compact of claim 66, wherein the insert is configured to fit at least partially inside the shell.

68. (New relative to claims of the '486 patent) The compact of claim 67, further comprising a hinge configured to couple the base of the shell to the cover of the shell.

69. (New relative to claims of the '486 patent) The compact of claim 67, wherein the rim is configured to secure the insert at least partially within the shell.

70. (New relative to claims of the '486 patent) The compact of claim 69, wherein the rim is configured to couple the insert at least partially within the shell in the snap fit arrangement.

71. (Amendments relative to Claim 14 of the '486 patent) A makeup case for holding a cosmetic substance, the case including a cover and a base, [the base including makeup,] the cover being movable to an [upper,] open position and to a [lower,] closed position, an improvement comprising:

a hermetic seal when the cover is in the [lower,] closed position whereby the seal maintains the cover in the closed position;

an outer body configured for retaining the cover and the base within the body.

72. (Amendments relative to Claim 15 of the '486 patent) The makeup case of claim [14] 71, wherein the seal [is comprised of] comprises a groove associated with the cover and a peripheral rim associated with the base, the rim being received in the groove when the cover is in the closed position.

73. (Amendments relative to Claim 16 of the '486 patent) The makeup case of claim [15] 72, wherein the improvement makes an audible sound when the cover is brought to the closed position.

74. (Amendments relative to Claim 17 of the '486 patent) The makeup case of claim [16] 73, wherein the improvement makes another audible sound when the cover is brought to the [upper] open position from the closed position.

75. (Amendments relative to Claim 18 of the '486 patent) The makeup case of claim [15] 72, wherein the groove includes a first peripheral wall and an edge.

76. (Amendments relative to Claim 19 of the '486 patent) The makeup case of claim [18] 75, wherein [all components associated with the seal are] the base is integral [the base and] with the cover.

77. (Amendments relative to Claim 20 of the '486 patent) The makeup case of claim [19] 76, wherein the first peripheral wall is shorter than the edge.

78. (New relative to claims of the '486 patent) The makeup case of claim 71, wherein the outer body comprises a container.

79. (New relative to claims of the '486 patent) The makeup case of claim 78, wherein the container comprises a shell.

80. (New relative to claims of the '486 patent) The makeup case of claim 79, wherein the base and cover comprise an insert.

81. (New relative to claims of the '486 patent) The makeup case of claim 80, wherein the size of the base of the insert corresponds to the size of the base of the shell.

82. (New relative to claims of the '486 patent) The makeup case of claim 81, wherein the insert is configured for retention within the shell in a snap fit arrangement.

83. (New relative to claims of the '486 patent) The makeup case of claim 79, wherein the rim is configured to secure the insert at least partially within the shell.

84. (New relative to claims of the '486 patent) The makeup case of claim 83, wherein the rim is configured to couple the insert within the shell in a snap fit arrangement.

85. (New relative to claims of the '486 patent) A compact for storing makeup comprising:

a first platform coupled to a second platform and configured for selective movement between a first position and a second position relative to the first platform;

a rim extending from the second platform;

a channel disposed between a first wall and a second wall of the first platform and having at least three sealing surfaces;

wherein when the second platform is in the first position the rim is received by the channel to provide a hermetic seal between the first platform and the second platform at two of the sealing surfaces.

86. (New relative to claims of the '486 patent) The compact of claim 85, wherein at least one of the sealing surfaces comprises a wall.

87. (New relative to claims of the '486 patent) The compact of claim 86, wherein the at least one sealing surface comprises a bulge.

88. (New relative to claims of the '486 patent) The compact of claim 87, further comprising a housing configured to receive the first platform and the second platform.

89. (New relative to claims of the '486 patent) The compact of claim 87, wherein the channel has a width less than the width of the rim.

90. (New relative to claims of the '486 patent) The compact of claim 87, wherein the rim comprises a curved terminal end.

91. (New relative to claims of the '486 patent) The compact of claim 87, wherein the bulge is curved.

92. (New relative to claims of the '486 patent) A container for storing cosmetics comprising:

base means for providing a base;

cover means for providing a cover selectively positionable between a first position and a second position relative to the base means;

seal means for forming a hermetic seal between the cover means and the base means wherein the seal means comprises:

a curved rim extending from one of the cover means or the base means and a groove configured for receiving the rim disposed between a first wall and a second wall extending from one of the cover means or the base means;

a housing configured for retaining the base means and the cover means;

wherein the hermetic seal is formed when the cover means is in the first position.

93. (New relative to claims of the '486 patent, subsequently cancelled) [The container of claim 92, wherein the seal means for forming the hermetic seal comprises

a curved rim extending from one of the cover means or the base means and a groove configured for receiving the rim disposed between a first wall and a second wall extending from one of the cover means or the base means.]

94. (New relative to claims of the '486 patent, subsequently cancelled) [The container of claim 93, wherein the seal means comprises a housing configured for retaining the base means and the cover means.]

95. (New relative to claims of the '486 patent) The container of claim 92,
wherein the seal means comprises an insert.